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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,286

09/21/2005

Jean-Christophe Castaing

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7590

03/03/2009

HEXION SPECIALTY CHEMICALS, INC.

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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

03/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,286	Applicant(s) CASTAING ET AL.	
	Examiner Paul Marcantoni	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Restriction-Withdrawn:

The applicants' election of calcium silicate hydrate is respectfully acknowledged in their 12/10/08 response. Applicants' election with traverse of Group I with traverse in their 10/24/08 response is also acknowledged. However, rejoinder of these two groups required that applicants elect Group II which they did not. Applicants did argue the merits of the restriction stating it is the same inventive concept or identical technical feature of the hydraulic inorganic binder composition. It would appear that for PCT type restrictions that applicants are correct and thus this restriction is withdrawn. However, it is noted that product claims of Group II all teach the same composition but only different intended uses of that product.

35 USC 102/103:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 32-48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leture et al. '743, Jiang '167 B2, Chatterji et al. '683 A1, Reddy et al. '803 A1 or '987 A1, Vijn et al. '955 A1 or '954 A1, or Prat et al '650 A1.

All of the above cited references teach a composition comprising either calcium silicate hydrate or precipitated silica (see claims for each reference) thus anticipating applicants' instant claims thus anticipating applicants' instant claims. Further, the particle size or specific surface area would appear within the claimed range as well. All prior art references teach powders or finely divided particles of calcium silicate hydrate or precipitated silica which would have the same accelerating effect in a hydraulic binder because it is the same component used by applicants in a hydraulic binder.

Even if not anticipated, the prior art teaches overlapping ranges of amounts which would at least render applicants' invention prima facie obvious to one of ordinary skill in the art. Also it is noted that applicants method is merely mixing of precipitated silica or calcium silicate hydrate with a hydraulic cement to obtain an accelerating property in said cement.

35 USC 112 Paragraph:

Claims 32-48 are rejected under the second paragraph of 35 USC 112 for failing to particularly point out and distinctly claim applicants' invention.'

The term "sufficient amount" alone is indefinite. Applicants can easily correct by simply providing means + "function" (which they are missing) claim language. In other words, a sufficient amount effective to accelerate the hydraulic binder. Without the

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functional language it also fails under 35 USC 112 sixth paragraph and thus is rejected also over that. Note that having the function in the preamble (for accelerating) does not appear enough to require the function be listed after the sufficient amount terms. Please easily correct by providing the functional language (ie --effective to accelerate the hydraulic binder--) in all instances used in the claims including claim 1 and others.

Claim 1 is also indefinite with respect to “silica with a high surface area”. The term high is relative and indefinite in this claim and all claims it is used. This can be easily rectified by amending to ---silica with a high surface area of at least 200 m²/g---. (see [0039] in applicants’ specification). Applicant can correct in claim 1 and all other claims it is used (without which it is indefinite). Note also that without this term it is unclear whether the accelerating effect of silica will occur. Silica sand is also silica but certainly will not provide an accelerating effect so hence the criticality of inserting the specific surface area in the claims. It is also insufficient that it is defined merely in the specification. While it is true that the claims may be read in light of the specification, it is improper to read the limitations of the specification into the claims. In re Yamato, 222 USPQ 93; In re Wilson, 149 USPQ 523; Graver Tank v. Linde Air Products Co. 80 USPQ 451 (Supreme Court).

The term step is misspelled in claim 34. Please correct.

In claim 43, an —of— is needed after “at least one” on line 2.

The terms “a degree of surface acidity” is indefinite in claim 45 especially with reference to “a degree of”. Delete “a degree of” to resolve this issue in Both instances it is used.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Marcantoni/
Primary Examiner, Art Unit 1793